



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,045	06/14/2001	Kyoko Kimpara	Q64919	5944
7590 04/28/2006 SUGHRUE, MION, ZINN, MACPEAK & SEAS 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3202			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3639	PAPER NUMBER

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,045

Applicant(s)

KIMPARA ET AL.

Examiner

Igor Borissov

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of the Claim recites both a storage medium and a system, which is confusing. It is not clear what the Claim is directed to: the storage medium or the system. Furthermore, the Claim as recited raises the question of how many statutory classes are claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furst (US 6,297,819) in view of Yates et al. (US 6,330,586).

Claims 3, 6 and 9.

Furst teaches a system, method and a computer-readable medium containing instructions for translating a Web-page from its native language into a desired language, said system comprising a contents server; a user terminal; and a conversion server, said method comprising:

contents providing processing in which said contents provider terminal provides said contents server with contents (Fig. 1, item 140; C. 5, L. 29) in which a non-programmed translation instructing banner (Fig. 1, item 116; C. 4, L. 40-41) including conversion implementing request information is arranged (C. 11, L. 65-67);

contents provider information registering processing in which said contents provider terminal (database server 149; Fig. 1; C. 6, L. 52-55) provides said conversion server (Fig. 1; item 130) with contents provider information including contents information and charging method information showing a method of charging (subscription window, C. 10, L. 26-28) for conversion of said contents, such that said contents provider information is registered on said conversion server (C. 6, L. 54 – C. 7, L. 7);

contents storing processing in which said contents server stores said contents provided by a contents provider (C. 11, L. 65-68);

contents transmitting processing in which said contents server transmits said stored contents to said conversion server by request of said conversion server (C. 11, L. 65 – C. 12, L. 3);

contents displaying processing in which said user terminal selects and displays said contents stored in said contents server (web browser which displays information from data base server 140, C. 5, L. 29; C. 11, L. 65-68, Fig. 1, item 112);

conversion request processing (translation application, C. 11, L. 65-68), in which said user terminal transmits conversion implementing request information used to make a request of said conversion server for the displayed contents in accordance with an instruction (subscription window) through said translation instructing banner (C. 10, L. 26-28);

converting processing in which said conversion server (Fig. 1; item 130) refers to said contents registered database (Fig. 1; item 140; C. 5, L. 29), and then acquires said contents from said contents server and converts the acquired contents (translation application, C. 11, L. 65-68) based on said conversion implementing request information received from said user terminal, and registers information that said conversion has been performed as use history information on a storing device (C. 7, L. 6);

conversion result transmitting processing in which said conversion server transmits said results of conversion of said contents to said user terminal (C. 11, L. 65-68);

conversion result displaying processing in which said user terminal inputs results of conversion of said contents from said conversion server and displays the input results of conversion of said contents (C. 11, L. 65-68);

conversion fee information transmitting processing in which said conversion server produces conversion fee information based on the registered contents provider information stored in said contents registered database and transmits said conversion fee information produced to said contents provider terminal (subscription window, C. 10, L. 26-28; Fig. 1, item 140)

conversion fee information inputting processing in which said contents provider terminal inputs said conversion fee information through said conversion server (subscription window, C. 10, L. 26-28; Fig. 1, item 130);

conversion fee charging processing in which said contents provider terminal charges said contents provider for said conversion fee, based on said conversion fee information (C. 10, L. 26-28).

While Furst teaches producing conversion information based on the registered contents provider information (C. 10, L. 26-28; Fig. 1, item 140); and collecting a history of preceding simplified or actual URLs requests (C. 7, L. 6), Furst does not specifically teach charging conversion fee based on both the registered contents provider information stored in said contents registered database and use history information registered.

Yates et al. teach a system and method for service provision by means of communications networks, wherein usage history and associated accrued charges for services rendered are monitored (C. 19, L. 49-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Furst to include charging fee for services rendered, as disclosed in Yates et al., because it would advantageously allow the business to collect revenue. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Furst in view of Yates et al. to include that said conversion fee based on *both* the registered contents provider information stored in said contents registered database (services rendered) and registered usage history, as

Art Unit: 3639

disclosed in Yates et al, because it would advantageously allow to provide discounts for said subscriptions to the most frequent users thereby stimulating the users to increase their usage time and profits to the system owners.

Claim 4. See reasoning applied to Claims 3 and 6.

Claims 5 and 7. Furst teaches, that in said conversion, said contents, when being described in a foreign language, are translated into contents described in a native language of a user (C. 11, L. 65-68).

Response to Arguments

Applicant's arguments filed 2/16/2006 have been fully considered but they are not persuasive.

In response to applicant's argument regarding Claim rejection under 35 U.S.C. 112, second paragraph in respect to Claim 9, specifically that the claim is directed to a storage medium storing a control program, it is noted that the preamble of the Claim recites both a storage medium and a system, which is confusing. Moreover, said recitation of said both storage medium the system raises the question of how many statutory classes are claimed.

Furthermore, the body of the Claim recites structural limitations of a system only, which is in contradiction to the applicant's statement that the Claim is directed to a storage medium. Therefore, Examiner maintains said rejection.

In response to applicant's argument that Furst does not disclose or suggest a "translation instructing banner including conversion implementing request information," it is noted that Furst does, in fact, teach said feature. Specifically, Furst teaches contents providing processing in which a non-programmed translation instructing

Art Unit: 3639

banner (Fig. 1, item 116; C. 4, L. 40-41) including conversion implementing request information is arranged (C. 11, L. 65-67).

In response to applicant's argument that Furst does not disclose or suggest that a "conversion implementing request" included in the banner is transmitted to a server (web site), it is noted that Furst explicitly teaches:

"A translation application tool translates a web page from its native language into a default language or a language of the user's choice. The tool transmits the context web page (or a link to the context web page) to a translation server, which produces a results web page that is sent to a client tool window for display." (C. 11, L. 65 – C. 12, L. 3).

In response to applicant's argument that Furst does not disclose or suggest a charging system or conversion fees, it is noted that Yates was applied for this feature. Specifically, Yates et al. teach providing services by means of communications networks, wherein usage history and associated accrued charges for services rendered are monitored (C. 19, L. 49-53). The motivation to combine references would be to collect revenue, as well as providing discounts for said subscriptions to the most frequent users thereby stimulating the users to increase their usage time and profits to the system owners.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

4/25/2006

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a large, stylized loop at the end.

IGOR N. BORISSOV
PRIMARY EXAMINER